



FEB 13 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to question 3 of the morning section and questions 7, 16, 23, 32 and 38 of the afternoon section of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On August 3, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and

37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the

answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning question 3 and afternoon questions 7, 16, 23, 32 and 38. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. Which of the following is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001?

(A) If a non-English reference is submitted in an information disclosure statement, the applicant shall include a copy of the translation if a written English-language translation of the non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(B) Each U.S. patent listed in an information disclosure statement must be identified by inventor, application number, and issue date.

(C) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(D) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(E) A copy of any patent, publication, pending U.S. application or other information listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) the information disclosure statement submitted in the earlier application is in full compliance with appropriate regulations.

The model answer is selection (B).

Application number of each patent is not required to be listed by 37 CFR § 1.98(b)(1), which provides "(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date." As to (A), the elements of (A) are found in 37 CFR § 1.98 (a)(3)(ii), which provides "(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c)." As to (C), the elements of (C) are found in 37 CFR § 1.98 (b)(5), which provides "(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages

of the publication, date, and place of publication." As to (D), the elements of (D) are found in 37 CFR § 1.98(c), which provides "[w]hen the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative." As to (E), the elements of (E) are found in 37 CFR § 1.98(d), which provides "(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section."

Petitioner argues that answer (E) is correct. Petitioner contends that the wording in answer (E) differs from 37 CFR 1.98(d) in the omission of the definition of other information and the lack of precision in the term "appropriate regulations."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the wording in answer (E) differs from 37 CFR 1.98(d) in the omission of the definition of other information and the lack of precision in the term "appropriate regulations", neither of these assertions, even if correct, are pertinent to the issue of whether answer (E) is not in accordance with proper USPTO practice and procedure regarding patent applications filed in March 2001. The elements of (E) are found in 37 CFR § 1.98(d), which provides "(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section." Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 7 reads as follows:

7. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

(A) The elements of the design application, if applicable, should appear in the following order:

- (1) design application transmittal form;
- (2) fee transmittal form;
- (3) application data sheet;
- (4) specification;
- (5) drawings or photographs; and
- (6) executed oath or declaration.

(B) The specification should include the following sections in order:

- (1) preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied;
- (2) cross-reference to related applications (unless included in the application data sheet);
- (3) statement regarding federally sponsored research or development;
- (4) description of the figure or figures of the drawing;
- (5) feature description; and
- (6) a single claim.

(C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

(D) The elements of the design application, if applicable, should appear in the following order:

- (1) design application transmittal form;
- (2) fee transmittal form;
- (3) photographs;
- (4) application data sheet;
- (5) specification;
- (6) drawings; and
- (7) executed oath or declaration.

(E) None of the above.

The model answer is selection (D).

Photographs and ink drawings may not appear in the same application. See §

1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. As to (A), (A) contains the elements set forth in 37 CFR § 1.154 (a), which provides "(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b))." As to (B), (B) contains the elements set forth in 37 CFR § 1.154 (b), which provides: "(b) The specification should include the following sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim." As to (C), (C) contains the elements set forth in 37 CFR § 1.154 (c), which provides "(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type." Since (D) is incorrect, (E) is not the right answer.

Petitioner argues that answer (E) is correct. Petitioner contends that (D) is also incorrect in the case of informal drawings.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is also incorrect in the case of informal drawings, photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. Whether an applicant fails to follow the rules in supplying informal drawings is not at issue. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

16. In June 1998 Michael buys a television set with a remote control for automatically changing channels on the television set. In June 2000, Michael moves to a new neighborhood and discovers while watching television that the remote control for his television not only changes the channels on his television set but also operates to open his neighbor's garage door. Michael, believing that people no longer need to have separate devices for operating their television and opening their garage doors, goes to a registered practitioner to seek patent protection on his new idea. The practitioner files a patent application in 2000. During the prosecution of the patent for the circuit board device, the practitioner files the following claims 11 and 12:

11. An electronic device comprising: circuitry; said circuitry operating to emit signals of a predetermined waveform; said signals being used to automatically change channels on a television set and automatically open the door of a garage.

12. A method for opening a garage door comprising using a television remote control device to emit signals, comprising the steps of:

- a) adapting a television remote control device to emit signals to open a garage door;
- b) pointing said television remote control device at said garage door; and
- c) actuating said television remote control to cause said garage door to open.

Which of the following is true?

(A) Since the television and remote control were sold in June 1998, claims 11 and 12 are barred by 35 U.S.C. § 102(b) since the device was on sale more than one year prior to the invention by Michael.

(B) Since the television remote control device was in public use more than one year prior to the filing date of the application, Michael may obtain the patent coverage for the method claim 12 but not the device of claim 11.

(C) Although the device was bought in June 1998, Michael did not use it to open a garage door until 2000. Since claim 11 requires that the signals of the remote control operate to open the garage door, the limitations of claim 11 are not met by the device bought in 1998, and 35 U.S.C. § 102(b) does not apply.

(D) Since Michael did not make the remote control himself and only inadvertently discovered that his neighbor's garage door opens when changing the channel on his television set, this is merely an inadvertent discovery and not entitled to patent protection.

(E) Whether or not claim 11 is patentable is solely a question of obviousness. Michael need only produce evidence of commercial success to overcome an obviousness rejection.

The model answer is selection (B).

When the article is preexisting, one may only secure patent protection of the method of using the article. Since claim 11 is defined in terms of circuitry and this circuitry was preexisting, claim 11 is not allowable. Cf. *Monsanto Co. v. Rohm & Haas Co.*, 312 F.Supp. 778, 164 USPQ 556 (ED Pa. 1970), aff'd, 456 F.2d 592, 172 USPQ 324

(CA 3), cert. denied, 407 U.S. 934, 172 USPQ 323 (1972) (new use of preexisting chemical as herbicide entitles applicant to method claims). (A) is incorrect because claim 12 is not barred by 35 U.S.C. § 102(b). As to (C), the remote control device was preexisting and claim 11 reads on the circuitry as it existed in 1995. (D) is incorrect. The manner of invention, whether it be by painstaking research or an inadvertent discovery of a new use is without significance. As to (E), claim 11 is not patentable based upon previous public use. The evidence of commercial success, which may be relevant for overcoming a rejection under 35 U.S.C. § 103, cannot overcome a rejection under 35 U.S.C. § 102.

Petitioner argues that answer (D) is correct. Petitioner contends that a method for opening a garage door comprising using a television remote control device is not a new use and the steps of operating such a device are precisely the steps used to operate a television remote.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a method for opening a garage door comprising using a television remote control device is not a new use and the steps of operating such a device are precisely the steps used to operate a television remote, the facts state people no longer need to have separate devices for operating their television and opening their garage doors. That is, the facts identify a new use. There is no reason to assume the facts are incorrect. The instructions state "Do not assume any additional facts not presented in the questions." Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. Mr. and Mrs. Noteworthy (Henry and Alice) are registered patent practitioners maintaining an office. After completing their busiest year since opening their practice, the Notworthys decide to take a break from their hectic business routine and embark on a two week vacation in Acapulco, Mexico. On the third day of their vacation, Henry fell ill, and was laid up in bed for two days. Feeling somewhat better on the second day of his illness, and bored while Alice was on the beach, Henry phoned his office and learned from his secretary that an Office action in a case that he had overlooked contained a shortened statutory period (SSP) which expires on the very same day. He immediately had the Office action faxed to him, and upon receipt, he worked feverishly to prepare a reply. Upon completion of the reply, Henry prepared a certificate of mailing in accordance with the suggested format set forth in MPEP § 512 and deposited the reply accompanied by the certificate of mailing, properly addressed to the USPTO, in the local

post office on the very same day before the post office closed. On the 5th day of their vacation, Alice became ill and required bed rest. While Henry was on the beach, Alice called her office and learned that one of her cases had a SSP expiring on the same day. Alice immediately had the Office action faxed to her. Upon receipt of the fax, Alice prepared a proper response and forwarded same to the USPTO by facsimile accompanied by a certificate of transmission in accordance with the suggested format set forth in MPEP § 512 and in compliance with 37 C.F.R. § 1.6(d). Assume the certificate of mailing and the certificate of transmission recite deposit and transmission dates that are the same as their respective SSP expiration dates. Also assume that both communications are received in the USPTO after their respective SSP expiration dates and are stamped with the actual date of receipt. Which of the following statements is true?

- (A) The application wherein Henry filed a reply is abandoned because the USPTO stamped date is controlling.
- (B) The application wherein Henry filed a reply is not abandoned because the certificate of mailing date is controlling.
- (C) The application wherein Alice filed a reply is abandoned because the USPTO stamped date is controlling.
- (D) Both the application wherein Henry filed a reply and the application wherein Alice filed a reply are abandoned.
- (E) Neither the application wherein Henry filed a reply nor the application wherein Alice filed a reply is abandoned.

The model answer is selection (A).

37 C.F.R. § 1.8(a)(1)(i)(A). MPEP § 512 states, "The Certificate of Mailing procedure does not apply to papers mailed in a foreign country." Since the Henry application was mailed in Mexico, the stamped date of receipt in the USPTO is controlling. (B) and (E) are wrong because the Henry application is abandoned. (C) and (D) are wrong because the Alice application was transmitted to the USPTO by facsimile. 37 C.F.R. §§ 1.6(d) and 1.8(a)(1)(i)(B). In such case, a Certificate of Transmission serves to avoid abandonment even though the transmission is from a foreign country. In this regard, MPEP § 512 states: "Under 37 CFR 1.8, a person may state on certain papers directed to the Office... the date on which the paper will be...transmitted by facsimile. If the date stated is within the period of reply, the reply in most instances will be considered timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply. The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country... ."

Petitioner argues that answer (E) is correct. Petitioner contends that Harry would discover the need for an extension of time before abandonment occurred or should consult his insurance agent.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Harry would discover the need for an extension of time before abandonment occurred or should consult his insurance agent, there is no reason to assume Harry subsequently sends in a petition for extension of time. The instructions state "Do not assume any additional facts not presented in the questions." The relevance of whether Harry should consult his insurance agent is not apparent. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 32 reads as follows:

32. Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling. Which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. § 101?

Claim 1. A composition for bonding asphalt shingles to wood sheathing and a method, comprising: a mixture of 10%A, 30%B, and 60%C, and adding an effective amount of D to decrease the viscosity of the mixture.

Claim 2. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the

mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D to decrease the viscosity of the composition.

Claim 3. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

The model answer is selection (B).

Patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 2 is not naturally occurring. MPEP § 2105. (A) is incorrect because claim 1 recites both a product and a process in the same claim and is therefore not within one of the statutory classes set forth by 35 U.S.C. 101. MPEP § 2173.05(p), subpart (II). (C) and (D) are incorrect because claim 3 is drawn to a naturally occurring composition. MPEP § 2105. (E) is incorrect because (B) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that claim 2 is unsupported by the disclosure in the sequence of steps and that the claim 2 is drawn to a naturally occurring substance.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that claim 2 is unsupported by the disclosure in the sequence of steps and that the claim 2 is drawn to a naturally occurring substance, as petitioner admits, the question asks about a rejection under 35 USC 101 and not under 35 USC 112, and patentability of a product claimed by a product-by-process claim is based on the product itself, and the claimed subject matter in claim 2 is not naturally occurring given the inclusion of D. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 38 reads as follows:

38. Which of the following statements concerning preliminary amendments is/are in accordance with proper USPTO rules and procedure?

- (A) A preliminary amendment filed in a continuation-in-part application cannot be disapproved if it is filed within three months from the December 7, 2000, filing date.
- (B) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time.
- (C) A preliminary amendment filed in a continued prosecution application cannot be disapproved if it is filed four months from the December 7, 2000, filing date with a petition for a one month extension of time and the appropriate fee for the extension.
- (D) A preliminary amendment filed in a continuation prosecution application after the filing date of the application cannot be disapproved.
- (E) None of the above.

The model answer is selection (A).

37 CFR § 1.115(b)(2) and (c) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54636 (September 8, 2000). (A) is correct because a continuation-in-part application is filed under 37 CFR § 1.53(b) and will not be disapproved according to 37 CFR § 1.115(b)(2)(i). (B), (C) and (D) are incorrect because a preliminary amendment will be disapproved if it is not filed on the filing date of the CPA. See, 37 CFR § 1.115(b)(2)(ii). (E) is incorrect because (A) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that because a first Office action cuts off the applicant's right to have any later-filed preliminary amendment considered by the Office, even if filed within the three month period, would not be entered.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that because a first Office action cuts off the applicant's right to have any later-filed preliminary amendment considered by the Office, even if filed within the three month period, would not be entered, the question asks whether a preliminary amendment can be disapproved. As the Federal Register notice

points out, Section 1.115(a) provides that a preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104. Further if any amendment is received after the mail date of the first Office action and is not responsive to the first Office action, the Office will continue the current practice of not mailing a new Office action responsive to that amendment, but simply advising the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. This does not constitute disapproval, but notification that the amendment is not responsive. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

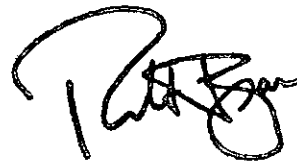
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no point have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy